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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,638	10/24/2003	Charlotte Famy	244625US0	7606

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,638

Applicant(s)

FAMY ET AL.

Examiner

Paul Marcantoni

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Restriction:

Applicant's election with traverse of Group I, claims 1-3 and 6 in the reply filed on 9/15/04 is acknowledged. The traversal is on the ground(s) that Group I and Group II are both identical products and are not mutually exclusive species to an intermediate-final product relationship. This is not found persuasive because the applicants' claim 1 is vague and it is certainly not clear exactly what applicants are claiming for their invention. Is it a generic product/composition in claim 1 or is it a panel? The applicants are literally claiming two statutory classes of invention in claim 1 in that it contains a composition and an article. It is also noteworthy to mention that applicants seem to wish to have it both ways and even argue Group I and II as both a product "and" a panel. In the first paragraph of their response, they argue that Groups I and II are the same or identical products. Then, in the last two lines on page 2 of their response, applicants argue that Groups I and II are drawn to a "panel". So which one is it in claim 1? Is it a panel or is it a generic compositional product? Because of applicant's vagueness with respect to what they are actually claiming, the restriction stands. Claim 1 was treated as a panel and claims 4-5 was treated as a composition, both different statutory classes of invention.

Thus, if applicants wish the examiner to withdraw the restriction and rejoin Groups I and II (claims 1-6), they must delete the phrase "in particular in panel form" so it is clear that they are only claiming a generic compositional product. If they refuse, rejoinder is respectfully denied for the proper reasons set forth under intermediate-final product relationship. Applicants may easily resolve this by deleting all reference to a

panel in claim 1 (in particular in panel form). Should they do so, claims 1-6 will be rejoined. Further, should they delete "in panel form", they can add it to claim 6 or another dependent claim off of claim 1 as an intended use claim. More so, should applicants agree to delete "in particular in panel form" in claim 1, they are reminded that the addition of new claims directed to a panel or cladding element or partition element (in the preamble and thus claiming the actual article) will be treated as claims non-elected by original presentation.

The applicants argue that inventions I and II should be also rejoined with III. The examiner disagrees. This depends upon how applicants amend their claim 1 (if at all) whether they resolve the situation stated above because a generic product is a compositional claim and a panel is an article. Should they delete any reference to a panel, then the generic product is not necessarily a panel. It can also be siding, roofing, slabs, corrugated sheet, flat sheet, etc. In other words, the generic compositional product can be a materially different invention because it is directed to making a different article.

It is noted that should applicants delete the reference to a "panel" in claim 1, they cannot combine or have rejoinder with claim 7 because it is directed to a panel. Should they not amend claim 1, this claim will be treated as a panel. If this is the case, it would mean that applicants mean to claim a "panel" and not a generic compositional product. They should then amend their preamble to indicate a "panel" is what is being claimed for their invention and not a generic compositional product. The applicants have also argued, assuming that Group I is a panel and Group III is a generic

compositional product, that there is no evidence that a panel can be made by pouring and casting, injection molding, extrusion, etc. In rebuttal, there is evidence. Applicants are referred to Merkley et al. '745 B2 wherein they teach panels (see col.1, line 49) can be made by the Hatschek process and other fabrication processes such as extrusion, injection molding, filter press, and flow-on machines. Gleeson et al. '697 B2 also teach different processes to make a panel including the Magnani process (see col.5, last paragraph and col.6, first paragraph) This meets the requirements that the vaguely claimed panel of Group I can be made by multiple different processes.

For the foregoing reasons, restriction is proper. Applicants are again reminded that rejoinder will depend upon how they amend their claims in their next response. Only Group I was examined yet it can easily be rejoined to Group II should they delete reference to a panel in the preamble so the invention is directed to a composition and not an article. If applicants have any questions, they can always call the examiner regarding this situation for further clarification. The requirement is still deemed proper and is therefore made FINAL.

Rejection under 35 USC 102:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(a and b) as being clearly anticipated by Baes '672, Johnson et al. '775 or '159 or '415, Suzuki et al. '620, any of the James Hardie Research Pty Limited Patents (including Merkley '744 B2, '745 B2, '103 B2, Naji et al. '897 B2, Duselis et al. '146 B1 or '248 B1, or Gleeson et al. '697 B2), Barrable '335 or '555, Castro '609 B1, Gordon et al. '911, Ausborn et al. (DD 253421), Gregerson et al. (EP 263723), or Seto et al. (JP 62223046).

All of the above cited references teach a composition or product comprising at least one hydraulic binder, and pozzolan as well as cellulose fiber and/or synthetic fibers thus anticipating the instant invention (see respective claims and/or abstract of each patent or abstract). It is also noted that the product or panel (whichever applicant means) can be made by multiple different processes and still arrive at making the same panel. Product by Process claims do not patentably distinguish the product of reference even though made by a different process." In re Thorpe , 227 USPQ 964.

Rejection under 35 USC 103:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Baes '672, Johnson et al. '775, or '159, Suzuki et al. '620, any of the James Hardie Research Pty Limited Patents (including Merkley '744 B2, '745 B2, '103 B2, Naji et al. '897 B2, Duselis et al. '146 B1 or '248 B1, or Gleeson et al. '697 B2), Barrable '335 or '555, Castro '609 B1, Gordon et al. '911, Ausborn et al. (DD 253421), Gregerson et al. (EP 263723), or Seto et al. (JP 62223046) alone or in view of Johnson et al. '415.

All of the above cited references teach a composition or product comprising at least one hydraulic binder, and pozzolan as well as cellulose fiber and/or synthetic fibers. Not all the references, however, teach that the filler used to make their product is calcium carbonate. However, it is the examiner's position that it would have been an obvious design choice for one of ordinary skill in the art to use a known filler such as calcium carbonate which can ultimately molded to form a panel or other article. Johnson et al. '415 teach that the filler used in his process of making a sheet on a machine such as a Hatschek machine may be an inert substance such as calcium carbonate or any other suitable substance. Thus, it is the examiner's position that it would have been an obvious design choice to use a specific filler such as calcium carbonate according to Johnson et al. '415 or any other inert filler that is within the teaching of the primary references.

Again, as stated above, the process of making the product claimed need not be the same to anticipate nor render obvious the instantly claimed generic compositional product in reference to In re Thorpe above.

Rejection under 35 USC 113 Second Paragraph:

Claims 1-3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 1 is indefinite because applicants are claiming two statutory classes of invention in a single claim. They claim a generic compositional product and a panel. It is not clear which one is being claimed and it is certainly improper to have both in the same claim. Further, claims 1-3 and 6 are rejected under 35 USC 101 because they are claiming two statutory classes of invention in a single claim. Namely, a composition and an article.

The terms "such as" repeated twice in claim 1 is vague and indefinite. Removal is advised.

Claim 1 should require the addition of both synthetic fiber such as polyolefin and cellulose fiber. Presently claim 1 only requires synthetic fiber which does not seem to be consistent with applicants' specification.

The terms "capable of undergoing" is vague and indefinite. Deletion of "capable of undergoing" and insertion therefor of —that undergoes—would resolve this issue in claim 2.

The terms "chosen from" is not proper Markush language. Amendment to —selected from the group consisting of—is advised in claim 2.

The term "preferably" is indefinite in claim 2. Deletion is advised.

The terms "such as " are indefinite in claim 3.

Claims 4 and 6 are improper multiple dependent claims because they refer back to another multiple dependent claim.

Claim 4 is indefinite because it is unclear how much of the 2 to 10 wt% fibers are cellulose fibers and how much exactly are synthetic fibers such as polyolefin or polyvinyl alcohol. Please specify the amounts of each kind of fiber in the claims to resolve this issue. Stating "at least some of which are synthetic fibers" is vague and tells nothing regarding the particular amounts of each kind of fiber.

The terms "additives" in claim 4 is vague and indefinite. Is the other ingredients such as cement, calcium carbonate, fibers, and pozzolan not also additives to the composition? Applicants should specify the specific additives they mean for their invention. Broadly stating additives does not particularly point out and distinctly claim their invention.

Abstract:

The abstract is improper because it must be a single paragraph. The last line is separated from the initial paragraph. Combining this last sentence with the paragraph to form a single paragraph would resolve this issue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni

Primary Examiner

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